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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,757	02/19/2002	Carlos F. Barbas III	TSRI 598.0 Con.1	7970

7590 01/13/2005

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EXAMINER
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HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Applicati n N .</b>	<b>Applicant(s)</b>	
	10/078,757	BARBAS ET AL.	
	<b>Examin r</b>	<b>Art Unit</b>	
	Larry R. Helms	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the corresp ndence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-3, 5-6, 9-10 have been amended

Claims 1-15 are pending and under examination.

2. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.

### ***Rejections Withdrawn***

3. The rejection of claims 1-15 under 35 U.S.C. 112, second paragraph under parts b-c, e-i in the previous Office Action, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn in view of the amendments to the claims.

4. The rejection of claims 1-11, 14, and 15 under 35 U.S.C. 103(a) as being unpatentable over Hoogenbloom et al (US Patent No: 5,565,332) in view of Adair et al (US Patent 5,859,205) is withdrawn in view of arguments.

5. The rejection of claims 1-15 under 35 U.S.C. 103(a) as being unpatentable over Hoogenbloom et al (US Patent No. 5,565,332) in view of Adair et al (US Patent 5,565,332) and Brooks et al (The Journal of Clinical Investigation, Vol. 96, pages 1815-1822 (1995)) is withdrawn in view of arguments.

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***Response to Arguments***

6. The rejection of claims 1-15 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained for paragraph 5a and 5d of the previous Office Action.

The response filed 10/18/04 has been carefully considered but is deemed not to be persuasive. The response states that the claims have been amended to obviate the 112 second paragraph rejections (see page 7 of response). In response to this argument, the claims are still indefinite because claim 1 still recites "in which each chain" in line 4 of claim 1 and it is unclear how each chain can have at least one CDR when only one chain is constructed. In addition, claims 5-15 are indefinite for reciting incomplete method claims as stated in the previous Office Action.

7. The rejection of claims 12-13 under 35 U.S.C. § 112, first paragraph, because the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention, because the specification does not provide evidence that the claimed biological materials are (1) known and readily available to the public; (2) reproducible from the written description is maintained.

The response filed 10/18/04 has been carefully considered but is deemed not to be persuasive. The response states that the LM 609 antibody is indeed the same as that recited in the claims had has been deposited with the ATCC under the provisions of

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the Budapest Treaty and a copy of the form BP 5/9 and a further communication from the ATCC are attached (see page 7 of response). In response to this argument, the response does not meet all of the requirements because the response does not include a statement that all assurances will be met such as if the deposit is made under the provisions of the Budapest Treaty, filing of an affidavit or declaration by applicant or assignees or a statement by an attorney of record who has authority and control over the conditions of deposit over his or her signature and registration number stating that the deposit has been accepted by an International Depository Authority under the provisions of the Budapest Treaty and that all restrictions upon public access to the deposited material will be irrevocably removed upon the grant of a patent on this application. This requirement is necessary when deposits are made under the provisions of the Budapest Treaty as the Treaty leaves this specific matter to the discretion of each State.

Applicant's attention is directed to In re Lundak, 773 F.2d. 1216, 227 USPQ 90 (CAFC 1985) and 37 CFR 1.801-1.809 for further information concerning deposit practice.

### ***Conclusion***

8. No claims are allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (571) 272-0832. The examiner can normally be reached on Monday through Friday from 6:30 am to 4:00 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew, can be reached at (571) 272-0787.

11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center telephone number is ~~703-872-~~


~~9306~~. 571 272 8300

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Larry R. Helms

571-272-0832



LARRY R. HELMS, PH.D  
PRIMARY EXAMINER